REMARKS

Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1-2, 7, 9, 14, 18, and 35 have been amended, claims 4, 8 and 27-28 have been cancelled without prejudice, and new claims 36-37 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all elected claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC §112 Second Paragraph

Claims 2-3 and 9-10 have been rejected under 35 USC §112, paragraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention.

In response, claims 2 and 9 have been amended to replace the phrase "may be" with "is".

In view of the foregoing, it is submitted that the rejections under 35 USC §112, paragraph 2, have been overcome and should be withdrawn.

Rejection Under 35USC §103

Claims 1, 5-7, 11-14, 18-19, 22-23, and 35 have been rejected under 35 USC §103(a), as

being unpatentable over U.S. patent application publication 2002/0078241 to Vidal et al. ("Vidal") in view of U.S. patent 5,991,713 to Unger et al. ("Unger"). Applicants respectfully traverse the rejection and request reconsideration

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)*. The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 1, and its dependent claims 5-6, is respectfully traversed for at least the following reasons. Claim 1 recites:

"1. (Currently amended) A method of responding to a request for information, the method comprising:

caching a compression dictionary at a server;

receiving at the server a request for information from a requestor, wherein the request is in compressed form;

decompressing the received request for information at the server using the cached compression dictionary;

compressing the requested information at the server using the cached compression dictionary; and

sending the compressed information from the server to the requestor with an identifier of the compression dictionary." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations. The features of the present invention are neither disclosed nor suggested by the combined references in that the request for information that is received from the requestor is not in compressed form, and thus decompression of the received request using the cached compression dictionary is not performed.

The Vidal reference discloses compressing a media file and streaming the compressed version to reduce the amount of data transmitted through the communication link (para. [0011], [0015]). When the server on which the compressed media file is stored receives a request, it transmits the media file in compressed form (para. [0036]; Fig. 4). However, there is no teaching in the Vidal reference that the request is in compressed form, nor that the request is decompressed at the server after receipt.

The Unger reference discloses compressing a collection of compiled hypertext material in order to reduce the size of the material and thus the transmission time (col. 8, lines 45-48; col. 14, line 62 – col. 15, line 2). When the server on which the compiled hypertext material is stored receives a request, it transmits at least part of the material in compiled and compressed form (col. 14, lines 13-17). However, there is no teaching in the Unger reference that the request is in compressed form, nor that the request is decompressed at the server after receipt.

In rejecting now-canceled claim 4, the Office states that paragraphs 43-44 and 47, and Fig. 6, of the Vidal reference teach decompressing a received request for information from a requestor (Office Action, p.5). Applicant respectfully disagrees. The cited paragraphs and Figure are directed to the method performed by decompress program 24 of user station 20 after the requested information has been received from the server. It does not discuss the request received by the server, and particularly does not disclose that the request is in compressed form or that the server decompresses the received request for information using a compression dictionary cached at the server.

In addition, in rejecting now-canceled claim 8, the Office states that paragraphs 39-41, and Figs. 5-6, of the Vidal reference teach compressing a request for information (Office Action,

p.6). Applicant respectfully disagrees. The cited paragraphs and Figure are directed to compressing the information itself, not to compressing the request for the information.

The features of the present invention are neither disclosed nor suggested by the Vidal reference in combination with the Unger reference. Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 7 and 35 (both currently amended) each recite limitations similar to those of claim 1, discussed above.

Claim 7 recites:

"7. (Currently amended) A method of sending a request for information, the method comprising:

caching a compression dictionary at a client;

compressing a request for information at the client using the cached compression dictionary;

sending the compressed request for information from the client to a server;

receiving at the client the requested information from the server, wherein the information received is compressed; and

decompressing the requested information at the client using the cached compression dictionary." (emphasis added)

Claim 35 recites:

"35. (Currently amended) A method of responding to a request for information, the method comprising:

creating a compression dictionary tailored for selected information;

receiving a request for at least a portion of the selected information from a requestor, wherein the request is in compressed form;

decompressing the received request using the compression dictionary;

customizing the information for the requestor;

dynamically compressing the customized requested information using the compression dictionary; and

sending the compressed information to the requestor with an identifier of the compression

dictionary." (emphasis added)

For similar reasons as explained heretofore with regard to claim 1, the features of the present invention are not taught or suggested by the cited references in that the request for information is not in compressed form, and thus compression or decompression of the request using a compression dictionary is not performed.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection of independent claims 7 and 35, and their corresponding dependent claims 11-14, is improper at least for that reason and should be withdrawn.

The rejection of independent claim 18, and its dependent claims 19 and 22-23, is respectfully traversed for at least the following reasons. Claim 18 recites:

"18. (Currently amended) A method of communicating over a network, the method comprising:

creating a compression dictionary;

publishing the compression dictionary on a network resource, wherein the compression dictionary is available upon request across the network;

retrieving the compression dictionary from the network;

caching the compression dictionary; and

compressing and decompressing messages received or sent according to the compression dictionary, wherein the messages include markup tags, and wherein the markup tags are compressed and decompressed." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations. The features of the present invention are neither disclosed nor suggested by the combined references in that the messages sent or received do not include markup tags which are compressed and decompressed.

The Vidal reference is directed to compression of streaming media files, such as Macromedia Flash movie files (para. [0003]-[0008]), rather than to files that include markup

tags. Accordingly, there are no markup tags to be included in the messages of the Vidal reference.

The Unger reference is directed to compression of files that include markup tags. However, the Unger reference teaches that the markup tags are not compressed:

"In step 204, the compiler parses the hypertext file in order to separate the tags from the corresponding text and objects. A correspondence table is created to preserve the relationship between the tags and the corresponding text and objects.

In steps 206 through 214 the compiler compresses the text contained within the files and stores the compressed text in accordance with a preferred method of compression and storage." (col. 8, lines 40-48; emphasis added)

Therefore, the applied references do not teach or suggest all of Applicant's claim limitations.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. The Unger reference teaches away from the combination proposed by the Office in that the markup tags of the Unger reference are not compressed and decompressed.

In addition, if the markup tags of Unger were to be compressed, the Unger reference would become inoperative for its intended purpose. "If references taken in combination would produce a 'seemingly inoperative device', we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness" *McGinley v. Franklin Sports Inc., 60 USPQ2d 1001, 101 (Fed. Cir. 2001)*.

The intended purpose of the Unger reference is to provide "efficient compression, storage, and transmission" of files such as hypertext markup language files stored within a distributed linked file system on the internet (col. 1, lines 9-12; col. 2, lines 24-25). As can be understood with reference to Fig. 8 of the Unger reference, the markup tags are separated from the text and objects of a hypertext markup language file but preserving the relationship between the tags and the corresponding text and objects (step 204), and then after the text and the objects have been compressed (steps 210 and 218), the separated-out markup tags are stored in a tag tree,

in uncompressed form (step 222; col. 12, lines 6-11). Having the tag tree accessible in uncompressed form such that parsing is not required is a key to efficient file transmission:

"Since it has received a complete summary of the structure of the hypertext information in the tag tree, the proxy Xl can determine without any reference to the tags what components it needs to transmit to the browser 82 (and in what order to transmit them) to allow the browser 82 to begin rendering as quickly as possible. Usually, most of the required components for rendering the requested material are transmitted by the remote server 10 in this initial transmission. If, however, the proxy determines that additional components are required (such as particularly large image or video files) by processing the tag tree 54 of the compiled file 52 that the proxy has received and cached, the proxy requests the additional components from the remote server 12 even while transmitting already received components to the browser 82 for rendering. When the proxy sends material to the browser 82, it decompiles and decompresses the compiled object effectively reconstructing the original format from the cached compiled components." (col. 14, lines 37-54)

"[T]he tag tree 54 in the compiled file 52 is readily available without parsing. Therefore, both the remote server 12 and the proxy can efficiently determine, based on the tag tree 54 in the compiled file 52 and the information transmitted what components are needed to render the page. The required information can be transmitted in fewer transmissions, without the browser 82 having to explicitly request each additional file or object that it needs from the remote server 12." (col. 15, lines 2-10)

If the tags were to be compressed along with the text and the objects, the tag tree would not be available without parsing, which would disadvantageously and adversely impact the efficiency of file transmission.

The features of the present invention are neither disclosed nor suggested by the Vidal reference in combination with the Unger reference. In addition, the Unger reference is not properly combinable with the Vidal reference. Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 2-3, 9-10, and 20-21 have been rejected under 35 USC §103(a), as being

unpatentable over U.S. patent application publication 2002/0078241 to Vidal et al. ("Vidal") in view of U.S. patent 5,991,713 to Unger et al. ("Unger"), and further in view of U.S. patent application publication 2002/0029229 to Jakopac et al. ("Jakopac"). Applicant respectfully traverses the rejection and requests reconsideration based on the dependence of these claims on one of independent claims 1, 7, and 18, whose reasons for allowability over the Vidal and Unger references have been discussed heretofore and against which the Jakopac reference has not been cited.

Conclusion

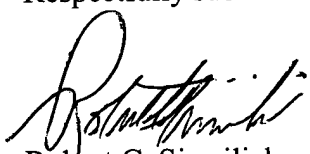
Attorney for Applicant has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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